



Paper No. 8

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OFFICE OF PETITIONS

In re Application of
Lee, et al.
Application No. 10/042,485
Filed: January 8, 2002
Attorney Docket No. 22738.00300
For: NETWORK CONFERENCING SYSTEM,
ATTENDANCE AUTHENTICATION METHOD
AND PRESENTATION METHOD

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3) &
CONSTRUCTIVE PETITION
UNDER 37 CFR 1.55(c)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 23, 2003 (certificate of mailing date June 18, 2003), to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed international application set forth in the amendment filed concurrently with the instant petition. In addition, the petition will be treated as a constructive petition under 37 CFR 1.55(c), requesting acceptance of unintentionally delayed claims under 35 USC 119 (a) - (d) for benefit of the filing date of the following foreign applications: Japanese Application Nos. P2000-149116, filed on May 19, 2000; P2000-149119, filed on May 19, 2000; and P2000-149120, filed on May 19, 2000.¹

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

The constructive petition under 37 CFR 1.55(c) is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;²

¹ A petition under 37 CFR 1.55(c) is required because the claims for benefit of the Japanese applications were first submitted on June 10, 2002. The claims had to be submitted within 4 months of the filing date of the instant application, or May 8, 2002, which is earlier than 16 months from May 19, 2000, or September 19, 2001. 37 CFR 1.55(a)(1)(i)

² Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it

- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on January 8, 2002, and was pending at the time of filing of the instant petition. A reference to the prior-filed international application, PCT/JP01/03911, has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant international application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed international application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed international application was submitted during the pendency of the instant nonprovisional application. *See* 35 U.S.C. § 120. As authorized, the \$1,300.00 fee required by 37 CFR 1.78(a)(3)(ii) was charged to petitioner's Deposit Account No. 50-2603. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed international application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date;
- (3) the surcharge, as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and
- (5) the nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The above-identified pending nonprovisional application was filed on January 8, 2002, which is after November 29, 2000, is a continuation of PCT/JP01/03911, filed May 10, 2001, which claims priority to Japanese Application Nos. P2000-149116; P2000-149119; and P2000-149120, all filed on May 19, 2000. PCT/JP01/03911 was filed within 12 months of May 19, 2000, which is the earliest filing date of the foreign applications to which benefit is claimed. The declaration filed on June 10, 2002 also identifies the foreign applications for which priority is claimed. Since petitioner has already paid the \$1,300.00 surcharge for the petition under 37 CFR 1.78(a)(3), a petition fee for the constructive petition under 37 CFR 1.55(c) will not be charged. Lastly, petitioner has provided an adequate statement of unintentional delay.

All requirements being met, the petition under 37 CFR 1.55(c) is **granted**.

A corrected Filing Receipt, which includes the priority claims to the prior-filed international application and the foreign applications accompanies this decision on petition.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

Petitioner is required to submit a certified copy of the foreign priority paper, prior to the granting of a patent. 35 USC 119(b)(3).

Any inquiries concerning this decision may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712.

This application is being forwarded to Technology Center Art Unit 2153 for examination in due course and for processing and consideration by the Examiner of applicant's claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (2) for the benefit of priority to the prior-filed international application and for consideration of the foreign priority claims under 35 USC 119(a) through (d) and 37 CFR 1.55(a).



Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt